



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

mc

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------------------------------------------------------------------|-------------|----------------------|-------------------------|------------------|
| 09/900,342 | 07/05/2001 | Nagesh S. Kommareddi | 194-12047-US | 4934 |
| 24923 | 7590 | 03/12/2004 | EXAMINER YOON, TAE H | |
| PAUL S MADAN MADAN, MOSSMAN & SRIRAM, PC 2603 AUGUSTA, SUITE 700 HOUSTON, TX 77057-1130 | | | ART UNIT 1714 | PAPER NUMBER |

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/900,342 | KOMMAREDDI ET AL. | |
| | Examiner | Art Unit | |
| | Tae H Yoon | 1714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-7, 13-24, 29-39, 45-56 and 61-64 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 33-39, 45-56 and 61-64 is/are allowed.
 6) Claim(s) 1-7, 13-24 and 29-32 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

Art Unit: 1714

A proper terminal disclaimer is acknowledged.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 98/16586.

Rejection is maintained for reason of record and following response.

Claim 1 recites that the shell acts as an anti-agglomeration agent (without particular materials), and claim 5 recites that a coating of an anti-agglomeration agent is applied during and/or after the encapsulated compound is ground (without particular materials). Thus, the shell and said coating can be the same material in the claimed final product.

WO teaches a different process, but an invention in a product-by-process is a product, not a process. See *In re Brown*, 459 F2d 531, 173 USPQ 685 (CCPA 1972) and *In re Thorpe*, 777 F2d 695, 697, 227 USPQ 964 (Fed. Cir. 1985). Thus, it is an anticipation as well as obviousness since a different process is recited. However, usually no statement regarding said obviousness is needed in this type of rejection since the reason under the inherency (which is an anticipation) is used, and a burden is on the applicant to show that his product (obtained from the process) is different from that of the prior art.

WO teaches a stable, nonagglomerating powders in abstract and thus the wax of WO inherently acts as an anti-agglomeration agent. Applicant states that the core and shell are reactively linked. But, applicant also states that said reactively linked does not necessarily meant a covalent bond between the core and shell, but rather any adhesive force such as static force or hydrogen bonding. The examiner position is that the wax and polymer of WO inherently possess such adhesive force.

Claims 13-24 and 29-32 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kommareddi et al (US 6,126,872).

Rejection is maintained for reason of record and following response.

With respect to claims 13-16, the monomer in a core is polymerized in the presence of a pre-polymerized catalyst, and thus the claimed invention is a polymeric

core encapsulated with a shell. Thus, the polymeric core of Kommareddi et al meets the instant invention and applicant failed to show otherwise.

With respect to claims 17-20, claim 22 of Kommareddi et al teach polyethylene oxide being the shell, and said polyethylene oxide encompasses any molecular weight and applicant failed to show any criticality of the recited molecular weight.

With respect to claims 21-24, the step of showing removal of water is not required in the claimed product.

With respect to claims 29-32, the claimed invention is a product, not a process, and the instant claims do not recite any limitation with respect to the polymeric core. Applicant failed to show the claimed polymeric core is different from that of Kommareddi et al. As a matter of fact, Kommareddi et al teach the use of the instant main ($TiCl_3$) and co-catalyst (diethylaluminum chloride and diethylaluminum ethoxide) in example 1 (col. 8, lines 19-23) contrary to applicant's assertion.

Claims 13, 15, 21, 22, 24, 29 and 31 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Martin (US 2003/0113445).

Rejection is maintained for reason of record and following response.

The core-shell polymer of Martin inherently meets the instant product absent a particular polymer (or monomer) and polymerization methods. The limitation such as a high molecular weight found in the specification cannot be read into the claim (as limitation). Again, an invention in a product-by-process is a product, not a process. See

In re Brown, 459 F2d 531, 173 USPQ 685 (CCPA 1972) and *In re Thorpe*, 777 F2d 695, 697, 227 USPQ 964 (Fed. Cir. 1985).

Claims 1-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over O'Mara et al (US 4,826,728).

Rejection is maintained for reason of record and following response.

The TCP inherently acts as an anti-agglomeration agent and would have an adhesive force. Again, an invention in a product-by-process is a product, not a process. See *In re Brown*, 459 F2d 531, 173 USPQ 685 (CCPA 1972) and *In re Thorpe*, 777 F2d 695, 697, 227 USPQ 964 (Fed. Cir. 1985).

Claim 1 recites that the shell acts as an anti-agglomeration agent (without particular materials), and claim 5 recites that a coating of an anti-agglomeration agent is applied during and/or after the encapsulated compound is ground (without particular materials). Thus, the shell and said coating can be the same material in the claimed final product.

Method claims 33-39, 45-56 and 61-64 are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tae H Yoon
Primary Examiner
Art Unit 1714

THY/March 8, 2004